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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,725	03/15/2004	Steffen Laux	0739-0137PUS1	2062
2292	7590	10/21/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			PAYER, HWEI SIU CHOU	
			ART UNIT	PAPER NUMBER

3724

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,725	<b>Applicant(s)</b> LAUX, STEFFEN	
	<b>Examiner</b> Hwei-Siu C. Payer	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Detailed Action**

1. Applicant's election with traverse of Species I in the reply filed on 8-18-2005 is acknowledged. The traversal is on the ground(s) that a reasonable number of species is set forth in the present application. This is not found persuasive because applicant failed to submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2-5 are directed to the non-elected species and therefore have been withdrawn from further consideration.

3. To ensure proper consideration of the prior art document EP 0 186 222 B1 cited on page 2 of the specification, Applicant is requested to provide a copy of the above document in response to this Office action.

## **Drawings Objection**

The drawings are objected to because:

(1) In Fig.1, reference numeral "35" (the one pointing to the shoulder of cutting element 31) should read --35a--.

(2) Fig.3 does not agree with page 7, lines 10-11 of the specification.

Specifically, angle "39" shown in Fig.3 is about 75 degrees rather than 30 degrees as

described in the specification, and angle "38" shown in Fig.3 is about 30 degrees rather than 70 degrees as described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### **Objection to the Abstract**

The abstract of the disclosure is objected to because the form and legal phraseology such as "means" should be avoided.

Correction is required. See MPEP § 608.01(b).

### **Objection to the Specification**

The disclosure is objected to because of the following informalities:

- (1) On page 6, line 14, "11" should read --12--.
- (2) On page 6, line 20, "witz" is not understood.
- (3) On page 7, line 10, after "38", --,-- should be added.
- (4) On page 8, line 26, "35a" should read --35--.
- (5) On page 9, line 9, "38a" should read --38--.
- (6) On page 9, line 15, "11" should read --16--.

Appropriate correction is required.

### **Claims Objection**

Claims 1 and 6-10 are objected to because of the following informalities:

- (1) In claim 1, lines 6 and 9, "cutting means" should read --the cutting means-- since it refers to the one previously cited.
- (2) In claim 1, line 7, "cutting elements" should read --the cutting elements-- since it refers to the one previously cited.
- (3) In claim 1, line 8 "guide shoulders" should read --the guide shoulders-- since it refers to the one previously cited.
- (4) In claim 6, lines 2 and 4, "cutting means" and "cutting elements" should read --the cutting mean-- and --the cutting elements--, respectively, since they refer to the ones previously cited.

(5) In claim 7, line 2, "cutting elements" should read --the cutting elements--.

(6) In claim 8, "cutting elements" and "cutting means" should read --the cutting elements-- and --the cutting means--, respectively.

(7) In claim 9, line 2, "replaceable cutting elements" should read --the replaceable cutting elements--.

(8) In claim 10, lines 2 and 6, "cutting means" should read --the cutting means--.

(9) In claim 10, line 3, "handles" should read --the handles--.

(10) In claim 10, line 6, "outer free ends" should read --the front free ends-- (note line 3 of the claim).

(11) In claim 10, line 7, "said outer free ends" should read --said front free ends--.

Appropriate correction is required.

### **Claims Rejection - 35 U.S.C. 112, second paragraph**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, lines 1-2, "and the like" is vague and indefinite.

(2) In claim 1, line 2, "a pair of movable cutting means" is incorrect. As the disclosed invention is understood, the cutting tool comprises a stationary cutting means 11 and a movable cutting means 12. It is suggested "a pair of movable cutting means" be changed to --a stationary cutting means and a movable cutting means--. Also, "one of which" (at line 2) and "the other one of which" (at line 3) should be changed to --said stationary cutting means-- and --said movable cutting means--, respectively.

(3) In claim 1, line 5, "known-per-se replaceable, concavely shaped cutting elements" is vague. It is suggested "known-per-se" be deleted.

(4) Claim 6 does not agree with Figs.2 and 3. It is the cutting elements 30,31 not the cutting means 11,12 that have radially inwardly extending chamfered cutting angles 39,42 merging with corresponding relief angles 38 of the cutting elements.

### **Claims Rejection - 35 U.S.C. 103(a)**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. Patent No. 4,779,342) in view of Leipold (U.S. Patent No. 1,529,489) and Gilley (U.S. Patent No. 1,508,687).

Kobayashi et al. disclose a manual cable cutting tool comprising a stationary cutting means (3), a movable cutting means (4), a stationary handle (1), a movable handle (2), and cutting elements (5,6) substantially as claimed except the cutting elements (5,6) are not replaceable.

Leipold shows a manual pipe cutting tool comprising replaceable cutting elements (17,18).

It would have been obvious to one skilled in the art to modify Kobayashi et al. by making the cutting elements (5,6) replaceable to facilitate renewable of the cutting elements without discarding the remaining parts of the cutting tool as taught by Leipold (see page 1, lines 13-17).

The cable cutting tool of Kobayashi et al. as modified does not have shoulders on the cutting means for inserting with shoulders on the cutting elements for connecting the cutting means with the cutting elements.

Gilley shows a cutting tool comprising cutting elements (6) having shoulders (5) that are inserted flush in guiding shoulders (4) formed on cutting means (3), and centering means (7,8,9) for connecting the cutting means and the cutting elements.

It would have been obvious to one skilled in the art to further modify Kobayashi et al. by providing the tool with centering means and cooperating shoulders on the cutting elements and the cutting means for frictional and precise connecting the cutting elements and the cutting means as taught by Gilley.



Claims 7 and 9 are not patentably distinct over Kobayashi et al. as modified because the relief angles, the cutting angles and the hardness levels of the cutting elements depend more upon the type of material to be cut by the cutting tool than on any inventive concept.

#### **Indication of Allowable Subject Matter**

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### **Prior Art Citations**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mix, Whitaker, Jr., Bradley, Crause, Laux, Chen, Erbrick et al. '565 and '470, and Nordlin are cited as art of interest.

#### **Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

H Payer  
October 20, 2005

*H Payer*

~~Hwai-Siu Payer~~  
~~Primary Examiner~~